

REMARKS**Claim Status:**

Claims 1-52 are pending in the application, of which, claims 12-23, 35-49, 51 and 52 have been withdrawn from consideration. Claims 1-11, 24-34 and 50 have been rejected. Claims 1, 24 and 50 are independent.

Information Disclosure Statement Filed on May 15, 2003:

On May 14, 2003, Applicant filed an Information Disclosure Statement ("IDS") in the instant application and, shortly thereafter, received a postcard from the U.S. Patent Office ("PTO") acknowledging receipt of that IDS. The Examiner, however, advised the undersigned that the PTO does not appear to have any record of the IDS having been filed and instructed the undersigned to resubmit the IDS papers when preparing a response to the outstanding Office Action. Accordingly, enclosed herewith are courtesy copies of the IDS papers filed on May 14, 2003 together with a copy of the postcard from the PTO acknowledging receipt of those papers. Applicant respectfully requests that the Examiner consider the references cited therein and, upon doing so, return an initialed copy of the enclosed Form PTO-1449.

Rejection Under 35 U.S.C. §102(e)/103:

Claims 1-9, 24-32 and 50 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. patent No. 6,237,010 to Hui et al. ("Hui"). Claims 10, 11, 33 and 34 were rejected under 35 U.S.C. §103 as being unpatentable over Hui in view of U.S. Patent No. 6,426,801 to Reed. Claims 1, 24 and 50 are independent.

Applicant's invention, as defined by claim 1, requires:

"An image communication method for use by an image transmitting apparatus comprising:

a transmission step of automatically transmitting a plurality of image files indicated in a transmission image designation file to an external device;

a first list generation step wherein said image transmitting apparatus generates a list holding information indicative of the transmitted image files and information representing a transmission order of the image files transmitted in said transmission step; and

an output step of outputting the transmitted image files and the transmission order to an output device on the basis of the information held in the list.”

It is clear from the language of claim 1 that the first list generation step occurs after the transmission step has begun. For example, claim 1 recites “a first list generation step wherein said image transmitting apparatus generates a list holding information indicative of the *transmitted* image files and information representing a transmission order of the image files *transmitted in said transmission step*. Rather than defining the image files as ones “to be transmitted” as in, e.g., dependent claim 2 (“selecting ... a plurality of image files to be transmitted”), the first list generation step instead defines them as the “transmitted” image files and refers to information representing a transmission order of the image files “transmitted in said transmission step”. Thus, claim 1 expressly requires the first list generation step to occur after the transmission step has begun. This also is consistent with the disclosure of the instant application. See, e.g., p. 30, lines 9-21, “When transmission is ended, a log file ... is ... generated....”. Also, Applicant notes that the image files to be transmitted and the order of the image files to be transmitted are not always identical to the transmitted image files and the order of the transmitted image files, because, e.g., the former can be freely changed until the image files are actually transmitted, while the latter obviously cannot be changed.

Hui is directed to a multimedia application for use on a personal computer. The application in Hui permits a user to collect images from one or more sources, such as a digital camera or a scanner. Once collected, the user is permitted to correct the images by, e.g., changing color, tone, magnification, etc., and to “compose” one or more of the images by adding information such as written captions, audio information, etc. to the corresponding image file(s). Once the image composition has been completed, the application publishes the images to a video screen, the World Wide Web or a printer.

The Office Action cites col. 16, lines 47-59 of Hui as disclosing “a transmission step of automatically transmitting a plurality of image files indicated in a transmission image designation file to an external device”. That passage of Hui essentially discloses publishing a set of images selected by a user to one or more destinations such as a video screen, the World Wide Web or a printer. The Office Action also cites three passages in columns 7 and 8 of Hui as disclosing “a first list generation step wherein said image transmitting apparatus generates a list holding information indicative of the transmitted image files and information representing a transmission order of the image files transmitted in said transmission step”. (col. 7, lines 19-28 & 60-67; col. 8, lines 49-56) However, these three cited passages of Hui discuss the collection of image files for image correction and composition, prior to publication. Thus, to the extent that a list is even generated at that point, such list generation clearly occurs before transmission to an external device, and thus, is not “a list holding information indicative of the *transmitted* image files and information representing a transmission order of the image files *transmitted in said transmission step*”, as required by claim 1.

Furthermore, claim 1 requires the list generated in the first list generation step to hold, not only information indicative of the transmitted image files, but also information

representing “a transmission order of the image files transmitted in said transmission step”. Hui does disclose information added to FlashPix files during image composition. In particular, it discloses adding an author of the image, a capture date of the image, the hardware device used to capture the image and the settings on the hardware device. (See col. 8, lines 60-67; col. 8, lines 49-56; col. 16, lines 35-46) However, this additional information is not “a transmission order” and, for the reasons discussed above, is not “a transmission order of the image files transmitted in the transmission step”, as required by claim 1.

For each of the foregoing reasons, Applicant respectfully submits that claim 1 is clearly not anticipated by Hui. Claims 24 and 50 contain language similar to claim 1 and are not anticipated for the same reasons as set for above in urging the allowance of claim 1.

Dependent Claims:

Applicant does not believe it necessary at this time to further address the rejections of dependent claims 2-11 and 25-34, as Applicant believes that the foregoing places the independent claims in condition for allowance. Applicant, however, reserves the right to address those rejections in the future should such a response be deemed necessary and appropriate.

Status of the Corresponding Japanese Patent Application:

Applicant also wishes to take this opportunity to inform the Examiner that Japanese Patent Application 11-283462, which corresponds to claims 1-11, 24-34 and 50 of the instant application, has been allowed by the Japanese Patent Office. It was registered on July 11, 2003 as Japanese Patent No. 3450759.

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance, and an early and favorable examination on the merits is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required by this response or any paper filed herewith, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1232-4579. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 1232-4579. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

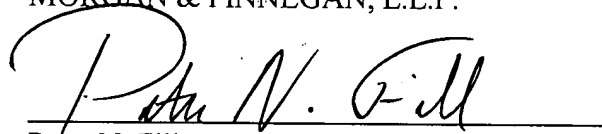
In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

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Dated: September 18, 2003

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